

REMARKS

I gratefully acknowledge the Examiner's determination that claims 32-35 contain allowable subject matter (Office Action, dated September 7, 2005, at 5, lines 3-6).

Claims 32-35 have been canceled without prejudice. Claims 21 and 31 have been amended and new claims 36 and 37 have been added. Specifically, claim 21 has been amended to incorporate allowable subject matter from dependent claims 34 and 35. Claim 31 has been amended to incorporate allowable subject matter from dependent claims 32 and 33.

New independent claim 36 corresponds to the subject matter of previous claim 21 and additionally recites "wherein the stud comprises a bar having ends, a first end member attached to one end of the bar and a second end member attached to an other end of the bar, wherein the bar is made of metal" as supported by original claim 7 and as supported on page 1, lines 6-10, and on page 4, lines 15-22, of the application as originally filed, and by the paragraph added by Preliminary Amendment (A), filed on October 31, 2003 with the original application, at page 5, lines 9-15, of the Preliminary Amendment (A).

New independent claim 37 corresponds to the subject matter of previous claim 31 and additionally recites "wherein the stud comprises a bar having ends, a first end member attached to one end of the bar and a second end member attached to an other end of the bar, wherein the bar is made of metal" as supported by original claim 7 and as supported on page 1, lines 6-10, and on page 4, lines 15-22, of the application as originally filed, and by the paragraph added by Preliminary Amendment (A), filed on October 31, 2003 with the original application, at page 5, lines 9-15, of the Preliminary Amendment (A).

The present amendment adds no new matter to the instant application.

The Invention

The present invention pertains broadly to a method for dispensing a substance into a mouth,

such as could be used to dispense a breath freshener, a flavoring agent, a medication, or a combination of these substances. In one embodiment of the present invention, a method of dispensing a substance into a mouth, wherein the substance is selected from the group consisting of a breath freshener and a flavoring agent, is provided comprising the steps recited in claim 21. In another embodiment of the present invention, a method of dispensing a substance into a mouth, wherein the substance is a medication, is provided comprising the steps recited in claim 31. In yet another embodiment of the present invention, a method of dispensing a substance into a mouth, wherein the substance is selected from the group consisting of a breath freshener and a flavoring agent, is provided comprising the steps recited in claim 36. In still another embodiment of the present invention, a method of dispensing a substance into a mouth, wherein the substance is a medication, is provided comprising the steps recited in claim 37.

Various other embodiments, in accordance with the present invention, are recited in the dependent claims. All of the embodiments, in accordance with the present invention, provide the advantage of using a “mouth and tongue stud” to dispense a substance into a wearer’s mouth.

The Rejection

Claims 21, 22, 28, 29 and 31 stand rejected under 35 U.S.C. § 102(a) as being anticipated by Katz (U.S. Patent 6,326,022). Claims 23-27 and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Katz (U.S. Patent 6,326,022).

Claims 21 and 31 stand rejected under the judicially created doctrine of obviousness-type double patenting over claim 30 of U.S. Patent 6,675,613 B2.

Applicant respectfully traverses the rejection and requests reconsideration of the application for the following reasons.

Applicant’s Arguments

Independent claims 21 and 31 now include allowable subject matter from dependent claims 34,

35 and 32, 33, respectfully. Therefore, claims 21 and 31 are allowable for the reasons of record.

Prior Art Rejection

Anticipation under 35 U.S.C. § 102 requires showing the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984). A prima facie case of obviousness requires a showing that the scope and content of the prior art teaches each and every element of the claimed invention, and that the prior art provides some teaching, suggestion or motivation to combine the references to produce the claimed invention. In re Oetiker, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992); In re Vaeck, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

In the present case, the Section 102 rejection is untenable and must be withdrawn because the reference fails to teach each and every element of the claimed invention, arranged as in the claims. For the same reason, the Section 103 rejection is untenable and must be withdrawn.

The Katz Patent

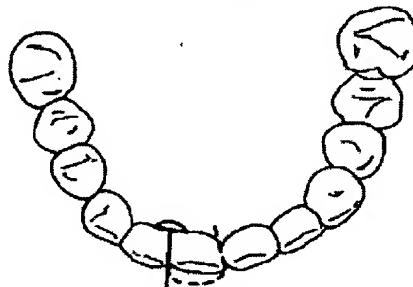
U.S. Patent 6,326,022 B1 to Katz (hereafter, the Katz Patent) teaches “slow-release disposable elastomeric buccal devices” as shown in Figures 1A, 1B, 1C, 3, 4, 5, 6, 7, 8, 9, 10, 12, 13, 14, 15, 19 and 20. As is clear from the Katz Patent, the device it discloses is constructed to be “held in a fixed position between two teeth in an unobtrusive manner” (col. 1, lines 23-26). It is a device that is “gripped and held between two teeth, due to the tendency of the stretched elastomer to return to its original thickness” (col. 3, lines 6-8). In fact, the “device can be inserted between any two teeth with the usual small gap between teeth” (col. 7, lines 43-47). Nowhere does the Katz Patent teach, or even suggest, that the device disclosed therein is suitable for use anywhere else but between two teeth.

In short, the Katz Patent fails to teach, or even suggest, a “mouth and tongue stud” in accordance with the present invention. The Federal Circuit has ruled that the United States Patent

and Trademark Office (USPTO) must give a fair reading to what a reference teaches as a whole. In *re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). In the present case, the Katz Patent plainly teaches a device constructed so as to be insertable between two teeth. On the other hand, a "mouth and tongue stud," in accordance with the present invention, is a device that is inserted in a fistulous tract in the mouth or tongue of the wearer (See page 2, lines 3-7, and page 4, lines 20-22, of the specification as originally filed). In fact, the device taught by Katz is preferably constructed so as not to extend into the mouth and cause annoyance to the tongue (col. 7, lines 22-26). For all of these reasons, the Katz Patent does not reasonably teach, or even suggest, a "mouth and tongue stud." Therefore, the Katz Patent cannot teach, or even suggest, the step of "providing a mouth and tongue stud..." as recited in independent claims 21 and 31.

However, this is not the only deficiency of the teachings of the Katz Patent. The Katz Patent plainly and clearly teaches that the device is inserted between any two teeth (col. 1, lines 23-25, and col. 7, lines 43-55). The device taught by Katz does not extend into the mouth to annoy the tongue and it does not extend against the inside of the lip (col. 7, lines 49-55). In other words, not only is the device taught by the Katz Patent not a "mouth and tongue stud" as evident from Figure 3 of Katz (reproduced below), but when in use the Katz device is not to contact the tongue or the lip (col. 7, lines 22-26 and lines 49-55).

F I G. 3



Plainly, the Katz Patent does not teach, or even suggest, "mounting the stud in a fistula formed in a part of a wearer's mouth" as recited in independent claims 36 and 37. A "fistula" is an abnormal passage from one epithelialized surface to another epithelialized surface (See Stedman's medical

dictionary (1995) at 657, of record). A gap between two teeth is not a “fistula.”

The Examiner argues that Webster’s Meridian dictionary provides some alternate definition of “fistula” (Office Action dated September 7, 2005, at 6, lines 4-8). However, the Examiner has not made a copy of the relevant page of her “dictionary” of record. I remind the Examiner of her obligation under the Administrative Procedure Act to show the evidence on which her findings are based. *In re Lee*, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002). Therefore, I respectfully traverse the Examiner’s assertion regarding an alternate definition of “fistula” as an impermissible official notice.

However, this is not the only deficiency in the teachings of the Katz Patent. New independent claims 36 and 37 recite that “the stud comprises a bar having ends...wherein the bar is made of metal.” The Katz Patent teaches that its “elastomeric buccal device” is gripped and held between the teeth due to the tendency of the stretched elastomer to return to its original dimensions (col. 3, lines 6-9, col. 7, lines 1-4, and Figure 3). No portion of the device taught by the Katz Patent is made of metal. Furthermore, if the stem of the device were made of metal, it would obliterate an essential feature of the device (i.e., the ability of the stem to increase in thickness and lock the device in place when positioned between two teeth). The Federal Circuit has held that a modification to a prior art device that obliterates an essential feature of that device is not justifiable under Section 103. *McGinley v. Franklin Sports, Inc.*, 60 U.S.P.Q.2d 1001, 1010-1011 (Fed. Cir. 2001).

Therefore, not only does the device taught by Katz not teach, or suggest, “the bar is made of metal” as recited in claims 36 and 37, the device taught by Katz cannot be modified to be made of metal because such a modification would obliterate an essential feature of the elastomeric buccal device, which includes stretching the stem and increasing the thickness of the stem when tension is released.

For all of the above reasons, the Examiner has not established either a prima facie case of anticipation, or a prima facie case of obviousness, against the subject matter of claims 36 and 37.

Non-statutory Double Patenting Rejection

Attached herewith is a timely terminal disclaimer in compliance with 37 C.F.R. 1.321(c). This

timely filed terminal disclaimer overcomes the non-statutory double patenting rejection over claim 30 of U.S. Patent 6,675,613 B2.

Conclusion

Claims 21-31 are allowable for the reasons of record. New claims 36 and 37 are allowable over the teachings of the Katz Patent because the Katz patent does not teach, or even suggest, (i) “providing a mouth and tongue stud;” (ii) “mounting the stud in a fistula formed in a part of a wearer’s mouth;” and (iii) “wherein the stud comprises a bar having ends...wherein the bar is made of metal” as recited in independent claims 36 and 37.

Lastly, the non-statutory double patenting rejection of the subject matter of claims 21 and 31 over claim 30 of the U.S. Patent 6,675,613 B2 is moot in view of the timely filed terminal disclaimer.

For all of the above reasons, claims 21-31, 36 and 37 are in condition for allowance and a prompt notice of allowance is earnestly solicited.

Questions are welcomed by the below-signed applicant.

Respectfully submitted,

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